

REMARKS

Claims 107-130 are new genus claims covering the disclosed novel additive package useful in phosphate ester based hydraulic fluids. These claims have not been previously filed in either the application that resulted in US patent 5,464,551 (hereinafter referred to as “the patent”) or this or any parent Reissue application.

Although applicant had the right to claim the novel combination of additives suitable for use in phosphate ester based aircraft hydraulic fluids in a genus claim in the application resulting in the patent, such claim to the novel combination of additives, through error and without deceptive intent, was not filed. In other words, an invention, fully supported by the application originally filed to obtain the patent, was not claimed and applicant’s only recourse to correct the error is by means of this Reissue application. Accordingly, as will be more fully pointed out below, the applicant claimed less than he had a right to claim and relies upon the provisions of 35 U.S.C. 251 to proceed with this Reissue application. No new matter is introduced into the application or claims in this reissue application. Furthermore, there is no issue with respect to the “recapture” rule because the invention now claimed was never before claimed. Thus no amendment to the presently presented new claims could have been made.

The earliest effective filing date of this application is within two (2) years of the issue date of the patent foreclosing any issue with regard to the scope of the claims.

The fact that the novel combination of additives now claimed has universal benefit in phosphate ester based hydraulic fluids has been fully supported in the record of this Reissue application. Several Declarations have been filed in the record of this application pointing out portions of the description of the invention showing the universal benefit of the novel

combination of additives with respect to prior art as well as novel phosphate ester based hydraulic fluids. These Declarations were filed together with the Request for Filing Continuation of Reissue application under 37 C.F.R. § 1.53(b) submitted under date of March 8, 2001 and are relied upon to support the scope of the invention now claimed.

The present claims are based upon the disclosure typically stated at Col. 6, lines 19-22 as follows:

“Moreover, it has been found that the additive combinations of this invention are effective in enhancing the properties of base stock compositions previously known in the art or otherwise differing from the preferred base stock of the functional fluids of this invention.”

This teaching provides the basis for the independent invention of the additive combination that is not dependent on a specific phosphate ester base stock. Also, it is evidence that the inventor knew and appreciated the presently claimed invention upon filing the application that resulted in the patent. Further evidence of the knowledge and appreciation by the inventor of the presently claimed invention is contained in the specification at Col. 3, lines 22-24 as follows:

“The invention is further directed to a fluid composition suitable for use as an aircraft hydraulic fluid and containing a novel combination of additives.” (Emphasis added)

Thus the inventor recognized and appreciated the invention of a novel additive package useful in phosphate ester based hydraulic fluids upon the filing of the application resulting in the patent.

Authority for allowance of the presently presented claims in a Reissue application is found in the decision In re Michael P. Doyle 293 F.3d 1355; 63 U.S.P.Q.2d 1161 (CCPA 2002) (hereinafter "Doyle"). In Doyle, the Board of Appeals and Interferences affirmed a final rejection of claims in a Reissue application based on the doctrine of In re Orita, 550 F.2d 1277, 193 U.S.P.Q.145 (CCPA 1977). The invention in Doyle was a genus of chiral transition metal catalysts and a method of using them to perform enantioselective reactions with prochiral starting material. The original application received a nine (9) way restriction requirement and included both composition of matter claims and method claims. The inventor elected one group, a group of method claims directed toward using the genus of catalysts to insert carbenes into carbon-hydrogen, oxygen-hydrogen, nitrogen-hydrogen, and silicon-hydrogen bonds. He cancelled the other pending claims. The groups that he did not elect and that are relevant to the appeal in Doyle pertained to a method of forming metal stabilized ylides, method of adding a hydrogen atom using a chiral catalyst; and a group of claims drawn to methods of adding silicon and hydrogen or boron and hydrogen using a chiral catalyst. The Doyle patent issued without the cancelled claims. No divisional applications directed toward the non-elected groups were filed during the pendency of the application.

Before the expiration of the two-year limit for broadening reissues, a request for reissue of the Doyle patent was filed. The reason for reissue was stated to be that the claims were too narrow in that they covered a process directed to carbenes only and they should have covered the use of the defined catalysts to enantioselectively catalyze reaction with a prochiral compound. The examiner rejected the new claims on three grounds: (1) defective reissue declaration for failure to specify an error correctable by reissue under the Orita doctrine; (2) recapture; and (3) obviousness-type double patenting over claims of an issued US Patent. The appeal was on the

first two grounds and the promise to file a terminal disclaimer to overcome the double patenting rejection. The Board confirmed the rejection (1) under the Orita doctrine in that the reissue declaration did not specify an error correctable by reissue and reversed the rejection (2) relating to recapture.

The reissue application of the patent was based upon an error in not presenting any linking claim so as to cover two or more of the non-elected inventions. The reissue application provided a means whereby linking claims could be provided and thus allowing the cancelled non-elected claims to be allowed in one patent. The legal determination by the Board with regard to the scope of reissue and the applicability of *In re Orita* to the undisputed facts of the case was reviewed *de novo*.

In *Doyle* the Court stated, quoting the decision *In re Weiler*, 790 F.2d 1576, 1579, 229 U.S.P.Q. 673, 675 (Fed. Cir 1986) that “The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” However, the Court distinguished *Orita* on the basis that the claims now presented in *Doyle* were broader than those contained in the original application and, by error without deceptive intent, were never claimed. Unlike *Orita*, linking claims were never entered in the application resulting in the *Doyle* patent. Further, *Orita* and other like cases based upon that doctrine were distinguished on the basis that *Doyle*’s linking claims now entered in the Reissue application could have been prosecuted in the application resulting in the *Doyle* patent together with his elected group. Therefore, an error existed in *Doyle*’s issued patent, i.e. failure to claim the broad genus claims. To explain the distinction in *Doyle* the courts stated:

“As noted above, this rationale underlies the decision in each of those cases [*Orita* and other like cases] where the patent in reissue

contained no possible error because the matter sought on reissue could not have been prosecuted originally. That rationale cannot apply to Dr. Doyle's reissue application, in which he points to error in the existing patent, namely, failure to claim as broadly as possible matter that could have been sought in the original application."

The present reissue application is on "all fours" with the Doyle decision. Like Doyle, the applicant herein could have filed the broad genus claim to the additive package together with the other more narrow claims to the additive package in combination with a phosphate ester to form an improved aircraft hydraulic fluid. Like Doyle, there was error in not filing a genus claim to an invention that was clearly known and appreciated as an invention by the inventor upon filing the application. As in Doyle, the reissue section of the patent code was enacted precisely to correct the kind of error that occurred in the prosecution of the application resulting in the patent.

Like Doyle there is no issue herein with respect to recapture because the new claims were never examined, much less amended in view of the prior art. The present Reissue application is more clearly allowable here than under the decision in Doyle in that there was no issue with respect to any restriction requirement. The present situation is one that is most applicable to the reissue section of the patent code in that the inventor, through error without deceptive intent, failed to claim a broad invention particularly pointed out to be an invention in the original application. As in Doyle, the omission of the new broader claims that could have been entered in the application resulting in the patent was an error correctable by recourse to reissue.

Application of: Gerbrand Deetman
Serial No.: 09/801,883
Preliminary Amendment

Accordingly, the examiner is respectfully requested to allow the claims in this reissue application with the broad genus claims, together with the specie claims containing the inclusion of a specific phosphate ester base stock.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date: August 11, 2006



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